

REMARKS

Claims 30-36 are pending in this divisional application. In the Office Action dated February 25, 2003, the Examiner maintained rejection of claims 30-36 based on the previous action dated September 26, 2002. In that Action, claims 30, 31 and 36 were rejected as anticipated by Brandt *et al.* claim 32 was rejected as obvious over Brandt *et al.* in view of Bapat *et al.* claims 33 and 34 were rejected as obvious over Brandt *et al.* in view of Herz, and claim 35 was rejected as obvious over Brandt *et al.* in view of Wollrath. The declaration pursuant to 37 C.F.R. § 1.131 filed with the response dated December 26, 2002, and received by the PTO on January 2, 2003, was considered, but the Examiner was of the opinion the declaration was ineffective to swear behind the priority reference date of Brandt *et al.*

Reconsideration of this RCE application is requested in view of the following remarks.

As an initial matter, the undersigned notes that in the present RCE application, the claims are amended in like manner to the amendments made to the sibling divisional application USSN 09/943,894 pursuant to agreement with Examiner England in a telephonic interview of June 12, 2003 regarding the same. In that interview, the Examiner agreed that the amendments clarifying that the electronic communication was an Email communication were sufficient to distinguish the invention over the art of record in the sibling application. The undersigned submits that the amendments to the present application reciting Email communication also distinguish the present invention over the art of record cited in the instant divisional application.

More specifically, the Examiner will recognize that Brandt *et al.*, is totally silent on the subject of managing Email communications, let alone managing Email communications in the manner claimed by applicant. Rather, Brandt *et al.* discloses an elaborate multi-component system for managing data reports sent to customers of an electronic data managing service. In particular, in the text cited by Examiner at column 21, line 57–column 22 line 35, Brandt *et al.* discloses “messaging middleware” used to coordinate report requests transmitted from a report manager (i.e. StarWRS) to a decision support server (DSS) reporting engine. The DSS in turn, sends a report completion notification to the report manager. The report manager formats the customer’s request for a report customized according to a “metadata” request message that is translated into a database inquiry, (see column 21, lines 43-55) according to a defined set of rules

and sends the request to the DSS as a "Talarian" message. Talarian messaging defines a message as types and subjects. This has nothing whatsoever to do with receiving an Email communication notification from a server that references a single copy of the Email communication, requesting the referenced Email communication and receiving the requested Email communication. Similarly, the text at column 4, lines 28-57 has nothing to do with requesting and receiving Email communication, but rather is directed to "managing the reporting of customer-specific data information in accordance with a customer request message..." (Column 4, lines 46-47). The text cited at column 16, lines 56 - column 17, line 36 refers to "various types of reports and messages received at the Inbox including all completed reports, call details, alarms and news" (see column 16, lines 59-61). This is certainly not an Email communication manager that stores a single copy of an Email message for distribution to one of a plurality of designated recipients. Rather, the Inbox is a tool for holding multiple types of information associated with the request for a report that is sent by the customer.

In addition, the problems solved by the system of Brandt *et al.* (i.e., mining a database for requested information according to a customer's criteria) are not relevant to the problem solved by Applicants invention, which is to minimize server storage use and save communication bandwidth by storing a single copy of Email communications until requested by each recipient. In fact, the elaborate system described by Brandt *et al.* would teach away from Applicants system because Brandt's system requires multiple levels of interacting software components that would demand much higher server storage capacity and require higher bandwidths for multiple back and forth communications between software components, database components and the customer. Moreover, because Brandt *et al.* is totally silent on the subject of Email communications, there is no teaching in Brandt *et al.* that would motivate one of skill in the art to manage Email communications in the manner claimed by Applicant.

The text cited by the Examiner at column 27, lines 1-15 also has nothing to do with Email communications. Moreover, this text teaches nothing related to deleting a single stored copy of an Email communication after receiving indications from a recipient to delete the single copy of the stored Email communication stored on the server. Rather, this text merely mentions the ability of a [single] customer to delete an existing report. The report is the final form of assembled information sent to the customer's machine after making a request for the report, not a single copy of stored Email communication residing on a server.

The deficiencies of Brandt *et al.* are not cured by the combination with Bapat, Herz, or Wollrath. Moreover, the combination of these references would not lead one of ordinary skill in the art to manage Email communications by storing a single copy of the Email communication, sending a notification of the Email communication to a recipient, and sending the copy of the Email communication to the recipient after receiving a request from the recipient.

Bapat, is more like Brandt *et al.* in being directed to database management tools. In particular, Bapat is directed to “an access control database [that] has access control objects that collectively store information that specifies access rights by users to specified sets of managed objects.” See Abstract. The text cited by the Examiner at column 14, lines 43-65 refers to an “event registry”, not to storing an Email communication notification locally, or for that matter, to storing any type of electronic communication locally after receiving the electronic communication notification. The event registry of Bapat “...is a software module that maintains a table of user event requests.” One of ordinary skill in the art would not equate storing an electronic communication notification sent from a server to the user, with a software module for storing a table of events sent from the user to a database access management system. Moreover; Bapat, like Brandt *et al.*, is totally silent on the subject of managing Email communications.

Herz also fails to disclose a system for managing Email communications. Herz is directed to a system that permits customized electronic identification of desirable objects, such as news articles, in an electronic media environment, and in particular to a system that automatically constructs a target profile for such objects based on the frequency with which selectable items, such as words, appear in an electronic article. In essence, Herz is directed to screening and selection of objects in an electronic media environment (e.g. the Internet) according to user defined criteria. Moreover, the text cited by the Examiner at column 39, line 57 – column 40, line 33 does not refer to using public and private encryption keys to encrypt any type of electronic message as characterized by the Examiner. Rather, the cited text discloses using decryption keys as a way of protecting users from unauthorized changes to their target profiles:

The user may likewise wish to ensure that other parties not tamper with user's user profile and target profile interest summary...This is done by providing for the user to apply digital signatures to the control messages sent by the user to the proxy server. Each pseudonym is paired with a public cryptographic key and a private cryptographic key, where the private key is known only to the user who holds that pseudonym.....[T]he proxy server uses the pseudonym's public key to

verity that the message has been digitally signed by someone who knows the pseudonym's private key. (Column 40, lines 19-33).

This has nothing to do with sending an Email communication from a server to one of a plurality of designated recipients based upon on retrieving public and private encryption keys.

Wollrath *et al.* utterly fails to teach anything about managing any electronic communication that is in any way related to Applicant's embodiments. Wollrath *et al.* is directed to a method of leasing server memory space to a plurality of clients over a distributed electronic network environment (e.g. the Internet). The text cited by the Examiner at column 13, lines 50- column 14, line 35 says nothing about performing any method on a receiving computer lacking sufficient permanent storage to store an electronic communication, let alone performing a method that is in any way related to Applicant's method. Therefore, the undersigned fails to understand the basis of the Examiner's citation of Wollrath, other than the fact that a user might be inclined to lease storage space on a server according to Wollrath if the user's local computer lacked sufficient space for the items the user would want to store on the server.

Turning now to the claims, the undersigned submits that the present amendment and above Remarks overcome the rejection of claims 30, 31 and 36 as anticipated by Brandt *et al.* As discussed above, Brandt *et al.* is directed to managing retrieval of reports by retrieving and assembling information from databases stored over a network. Brandt *et al.* does not teach or suggest anything related to a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email communication from a server that stores a single copy of the Email communication, where the method includes receiving an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication. Brandt *et al.* also does not teach that when a communication is no longer desired, indicating to the server to delete the communication, so that the server deletes the single stored copy of the communication after receiving indications from all recipients to delete the communication. Furthermore, Brandt *et al.* does not suggest that the contents of the received Email communication notification are based on preferences for one of the plurality of designated recipients, the preferences being previously supplied to the server. Accordingly, the undersigned requests withdrawal of the rejection of claims 30, 31 and 36 as anticipated by Brandt *et al.*

The undersigned also requests withdrawal of the rejection of claims 32-34 as obvious over Brandt *et al.* in combination with any of Bapat, Herz or Woolrath. First, as discussed above, these references also are not directed to managing Email communications and therefore do not cure the fundamental deficiency of Brandt *et al.* Therefore; on their face, the combination of these references with Brandt *et al.* fails to provide all the elements of the claimed invention.

In addition, Bapat, Herz or Woolrath fail to teach, suggest or provide a motivation to combine the features recited in claims 32-35. More specifically, there is no teaching or suggestion in these references to store an Email communication notification locally; and after indicating to the server to delete the Email communication, deleting the stored Email communication notification even if all recipients have not indicated to delete the Email communication. There is no teaching or suggestion to store the Email communication locally such that the locally stored Email communication is preserved even when the server deletes the single stored copy. There is no teaching or suggestion that the Email communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and retrieving a private encryption key for one of the plurality of designated recipients to decrypt the Email communication. There is also no teaching or suggestion to perform the method specifically on a receiving computer lacking sufficient permanent storage to store the Email communication.

Moreover, the undersigned respectfully submits that improper hindsight has been used in rejecting the claims over the combination of cited references. As discussed above, the cited references are directed to methods unrelated to the problem solved by Applicants invention. It appears that the Examiner has searched the prior art for the elements of Applicant's claims (e.g., public and private encryption keys, servers, electronic notifications and the like) in order to assemble a parts list of those elements. This parts list was then used to reconstruct Applicant's invention to support an obviousness rejection based on text from the references that uses some of the words used in Applicant's claims, but in a context that is unrelated to Applicants invention. This is classic hindsight. There must be some teaching, suggestion or motivation *from the prior art itself* that would motivate one to combine elements of the prior art to do what Applicant has done.

The present amendment is made solely to facilitate prosecution of certain embodiments of the invention and is not an acknowledgement that Applicant agrees with the rejection of the original claims or with the deficiency of the section 1.131 declaration with respect to Brandt et al. Accordingly, Applicant reserves the right to pursue the original claims or claims of different scope in one or more continuation applications.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

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Respectfully submitted,
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